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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent Application of:) Docket No.: 2771-645 (7495)
Applicant: BAUM, Thomas H.) Conf. No.: 4989
Application No.: 10/715,246) Art Unit: 1765
Date Filed: November 17, 2003) Examiner: DEO, Duy Vu Nguyen
Title: CHEMICAL MECHANICAL PLANARIZATION PAD) Customer No.: 25559
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)

FACSIMILE TRANSMISSION CERTIFICATE

ATTN: Examiner Duy Vu Nguyen DEO
Fax No. (571) 273-8300

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Number of Pages (including cover)

Steven J. Hultquist

September 28, 2005

Date

**RESPONSE TO RESTRICTION REQUIREMENT IMPOSED IN SEPTEMBER 2, 2005
OFFICE ACTION IN U.S. PATENT APPLICATION NO. 10/715,246**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This responds to the September 2, 2005 Office Action in the above-identified application, in which the Examiner imposed a restriction requirement against claims 1-22 pending in the application, between:

- Claims 1-17, drawn to a product (Group I);
- Claims 18-20, drawn to a method of making the product (Group II); and
- Claims 21 and 22, drawn to a method of using the product (Group III).

In response, applicant elects Group I claims 1-17. Such election is WITH TRAVERSE.

The traversal is based on the fact that the stated grounds for the restriction do not comport with the requirements of the 35 USC 121, which requires that:

"[I]f two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions."

The statute therefore requires as a basis for legally permissible restriction that the subject matter of respective claims be both independent and distinct.

Claim 1 is set out below for ease of reference:

**"1. A hydrophobic Chemical mechanical planarization (HCMP) pad comprising:
an organic polymer; and
a metal agent."**

Claim 18 requires:

"18. A method comprising mixing an organic polymer and a metal agent to form a chemical mechanical planarization (CMP) material." (emphasis added)

It is apparent from comparison of claims 1 and 18 that the subject matter of these claims includes as common subject matter a chemical mechanical planarization product comprising an organic polymer and a metal agent.

The Examiner's attention is directed in this respect to the provisions of MPEP Section 802 .01 (Meaning of "Independent" and "Distinct"), which states, *inter alia*:

"The term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect.."

It is apparent from this provision of the MPEP that the subject matter of Group I representative claim 1 and Group II representative claim 18 is not "independent" within the meaning of 35 USC 121 in the respective claims, and that therefore Groups I and II are NOT properly restricted.

The subject matter of claim 1 and claim 18 CANNOT BE CHARACTERIZED as being "unconnected in design, operation or effect" (MPEP Section 802.01). The restriction requirement applied against Groups I and II therefore is improper.

The Examiner has given as his reason for restriction an assertion that "the process [of the Group II claims] can be used to make other and materially different product such as a non-chemical mechanical planarization product." This statement however ignores the express recital in claim 18, which restricts the method to be a method "to form a chemical mechanical planarization (CMP) material."

Thus, by its own express language and limitation, and contrary to the examiner's assertion, the method of claim 18 cannot be used to form a non-chemical mechanical planarization product, for the plain and simple reason that such claim is limited to methodology "to form a chemical mechanical planarization (CMP) material."

The stated basis for restriction therefore is incorrect, and under MPEP Section 802.01, as well as the reason stated in the preceding paragraph, restriction is improper.

Based on all the foregoing, it is requested that the restriction requirement be withdrawn.

Further, it is pointed out that the subject matter of the respective claims imposes no serious burden of searching on the Examiner, particularly since Group II contains only three claims (claims 18, 19 and 20), and Group III contains only two claims (claims 21 and 22).

According to the MPEP section 803:

"[I]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP §803.

Under the applicable criterion of this MPEP provision, the Examiner is required to submit all claims 1-22 to examination on the merits.

Further, if the restriction requirement is made final (although no legally proper basis for such maintenance of the restriction requirement is present), applicant affirmatively requests rejoinder of the method claims 18-22 under the applicable rejoinder provisions of MPEP §821.04 upon confirmation of allowable subject matter in the product claims 1-17.

CONCLUSION

Based on the foregoing, the Examiner is requested to reconsider, and on reconsideration to withdraw, the restriction requirement imposed against claims 1-22 in the September 2, 2005 Office Action, and to submit all claims 1-22 to examination on the merits.

If any additional issues remain, the Examiner is requested to contact the undersigned attorney at (919) 419-9350 to discuss same, in order that the prosecution of this application is expedited.

Respectfully submitted,



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